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REMARKS

Claims 1-3 and 5 are amended. Upon entry of the amendment claim 1 with claims 2-4 and 6-8 depending therefrom; claim 5 (now amended to appear in independent form); and claim 9 with claims 10-18 depending therefrom are presented for reconsideration by the Examiner.

The amendment to claim 1 removes a comma and some unnecessary verbiage "in order". The amendment to claim 1 does not affect the scope of the claim, does not require a new search and places the claim in better condition for allowance or appeal, should an appeal be necessary.

The amendments to claims 2 and 3 address the claim objections raised by the Examiner. The amendments to claims 2 and 3 are clarifying in nature and do not alter the substantive scope of the claims.

Claim 5 is amended to add the recitations of independent claim 1 to create a new independent claim.

Entry of the Enclosed Amendment is Respectfully Requested

All of the limitations and relationships recited in pending claims 1-18 were present prior to the Office Action mailed December 1, 2003. Applicant respectfully states that the enclosed amendments add no new matter and raise no new issues for search. Further, the enclosed amendments correct deficiencies pointed out by the Examiner and place the claims in better condition for allowance, or appeal, should appeal be necessary.

The Examiner rejected claims 1-8, 12 and 14 as being obvious to one of skill in the art over U.S. Patent No. 4,189,198 to Reichman (hereinafter Reichman) in view of U.S. Patent No. 4,784,621 to Auclair (hereinafter Auclair).

The Examiner's Assessment of Reichman is Incorrect

In making this rejection the Examiner states "Reichman discloses substantially the claimed invention except for the ribs and channels." Applicant respectfully disagrees with this statement. Applicant directs the Examiner's attention to the recitations of claim 1 which recites in pertinent part:

a one piece movable member comprising a movable jaw, a second guide portion partially defining a receiving cavity, said receiving cavity configured for receiving said first guide portion in sliding engagement to guide longitudinal movement of said movable member with respect to said base to form a clamp, said first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs. (emphasis added)

The Examiner's statement of the disclosures of Reichman (office action mailed December 1, 2003, page 3) fails to identify any structure or numeric identifier from Reichman corresponding to the "receiving cavity" recited in claim 1. Reichman at column 3, lines 45-55 describes the relationship between the upper jaw member 34 and the vertical front face of rear wall 23. This sliding relationship prevents rotation of jaw member 34 relative to the clamp member 12 during tightening of the clamping screw 32. **The movable jaw 34 of Reichman does not define a receiving cavity configured for receiving said first guide portion in sliding engagement as recited in claim 1.**

The Examiner has failed to give the claim term "cavity" its broadest reasonable interpretation. The claim term cavity is given no special meaning by the Applicant and is used in its ordinary and accustomed manner. The claim term "cavity" must be given its broadest reasonable interpretation - as it would be understood by one of ordinary skill in the art in view of the specification and Figures. Applicant encloses dictionary pages from two authoritative references of the English language. Cavity is variously defined as "the state of being hollow", "a hollow place", "a three-dimensional discontinuity in the substance of a mass or body", "a space within a mass", or "a space hollowed-out". As clearly illustrated in Figure 1 and described at column 3, lines 45-55 of Reichman, the movable upper-jaw 34 does not define a "receiving cavity" "configured for receiving the first guide portion" as recited in claim 1.

Claim 1 recites "said first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs." Since the sliding interface between the upper jaw 34 and the inside surface of the clamp member 12 rear wall 23 is essentially a planar interface, there is no possibility for the implementation of opposed cooperative ribs and channels as recited in claim 1. As

previously discussed, the wholesale reconfiguration of the Reichman clamp member 12 and upper jaw 34 to incorporate the claimed structure is not suggested in Reichman or the knowledge of one of skill in the art.

Discussion of the Examiner's Proposed Combination of Reichman with Auclair

The Examiner acknowledges that Reichman further fails to disclose, teach or suggest the ribs and channels recited in claim 1. Reichman fails to disclose, teach or suggest the recited receiving cavity as well as the pair of opposing ribs and pair of opposing channels which cooperate with the ribs because Reichman uses an alternative (prior art) configuration where a rectangular upper jaw 34 is received in a c-shaped channel 12 and clamped against the bottom of the c-shaped clamp member 12 by a bolt 32 threaded through the c-shaped clamp member 12. This common prior art clamp assembly (also illustrated in U.S. Pat. No. 4,159,859 to Shemtov) does not require the recited receiving cavity and its associated ribs and channels. There is no teaching or suggestion that the clamp of Reichman is deficient or should be radically re-configured to resemble Applicant's invention. Further, there is no evidence that the more complicated interconnection of the base and movable member of Auclair is "stronger and more stable" than the arrangement disclosed in Reichman and Shemtov. Such a conclusion is not supported in the cited references.

The Examiner has Not Presented a Credible Motivation for His Combination of Reichman and Auclair

It is indisputable that to properly reach a conclusion as to obviousness pertinent case law requires that "there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Interconnect Planning Corp., v. Fell, 227 USPQ 543, 551 (Fed. Cir. 1985). In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983). Further, the prior art reference must be considered in its entirety, including portions that would lead away from the claimed

invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); see also M.P.E.P. §2141.02.

The burden is on the Examiner to demonstrate that the prior art evidences sufficient suggestion of the desirability of doing what the inventor has done. See M.P.E.P. §2142. At an irreducible minimum, this burden requires this Examiner to apply the facts of the case to "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Clearly, the Examiner cannot discharge himself from this burden by simply declaring all of the elements of an invention, along with the manner of combining these elements, to be well known in the art. Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989).

The Examiner addresses the deficiencies of the teachings of Reichman by resort to a combination with the teachings of Auclair. The Examiner's statement of the motivation to combine the teachings of Reichman with those of Auclair is:

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the connector of Reichman with the first guide portion and second guide portion, having a pair of opposing ribs and a pair of opposing channels which cooperate with the ribs, and securement means that extends through the movable member as taught by Auclair, to provide a stronger and more stable connection within the base and the movable member. (emphasis added)

There is no teaching or suggestion in Reichman that the disclosed c-shaped clamp member 12 and rectangular movable upper jaw 34 arrangement needed any improvement. Further, there is no evidence that the very different and much more complicated interconnection between the base and moveable member in Auclair is, in fact "stronger and more stable" than the clamp configuration disclosed in Reichman as asserted by the Examiner. There is simply no motivation for one of skill in the art to seek out the teachings of Auclair. It is significant that combining the teachings of Auclair with those of Reichman would require a wholesale redesign of the Reichman connector.

With particular reference to M.P.E.P. §2143.01, Applicant raises the following important and well-established legal principals.

1. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990); and

2. Because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levensgood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993); See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313,1318 (Fed. Cir. 2000).

It is well established that the prior art must suggest the desirability of the claimed invention. See M.P.E.P. § 2143.01. To quote: "There are three possible sources for a motivation to combine references: the nature of the problem to be solved; the teachings of the prior art; and the knowledge of persons of ordinary skill in the art." Citing *In Re Rouffet*, 149 F3d 1350, 1357 (Fed. Cir. 1998).

Applicant respectfully requests that the Examiner cite to a particular passage of Reichman that suggests the need for a more robust interconnection between the upper jaw 34 and the c-shaped clamp member 12. Support is also needed for the Examiner's contention that the very different and more complex interconnection between the moveable member and base disclosed in Auclair is, in fact, "stronger and more stable" than the arrangement disclosed in Reichman and Shemtov.

If the Examiner is relying upon the knowledge of skill in the art to support these assertions, Applicant respectfully requests citation to an appropriate reference teaching that knowledge or a signed statement by the Examiner attesting to knowledge that would give rise to such motivation. A *prima facie* case of obviousness cannot be made in the absence of a motivation to combine the reference teachings. The Examiner has failed to assert a credible motivation to combine the teachings of Reichman with those of Auclair.

The Examiner Has Failed to Present a *Prima Facie* Case of Obviousness with

Respect to Claims 1, 2-4 and 6-8

In sum, the Examiner has failed to establish a *prima facie* case of obviousness with respect to independent claim 1 for at least the following reasons:

1. The Examiner has failed to establish a credible motivation for combining teachings of Reichman with those of Auclair;
2. Even if combined, the references fail to disclose, teach or suggest all the limitations recited in claim 1; and
3. The Examiner employs an impermissible hindsight reference to Applicant's claims to combine the teachings of Reichman with those of Auclair to arrive at the claimed invention.

For all the foregoing reasons, claim 1 is patentable over the references cited by the Examiner. Claims 2-4 and 6-8 depend directly or indirectly from claim 1 and are patentable for all the reasons stated in support of claim 1.

Claim 5 is Patentable for at Least the Reasons Stated in Support of Claim 1

Claim 5 has been amended to incorporate the recitations of claim 1 and recites in pertinent part:

securement means that extends through the movable member for securing said base and movable member so that when a cable is received between said fixed jaw and said movable jaw, said jaws are securely clampable against said cable wherein said securement means comprises a first bolt engageable with said movable member **and threadably engaged to said base.** (emphasis added)

Claim 5 requires that the bolt extend through the movable member and threadably engage the base. Reichman does not disclose, teach or suggest the structures and relationships recited in claim 5. In particular, the securement means passing through the movable member to threadably engage the base would completely alter the principle of operation of the clamp and movable jaw disclosed in Reichman. As previously discussed, there is simply no motivation for one of skill in the art to attempt such a massive redesign of the Reichman clamp. The only apparent motivation for such a combination is found in Applicant's claims. A hindsight reference to Applicant's claims in the specification in formulating a prior art rejection is clearly impermissible.

Claim 5 is patentable for at least the reasons stated in support of claim 1 and

additionally patentable for the reasons discussed immediately above.

Claim 9 is Patentable for All the Reasons Stated in Support of Claim 1

The Examiner's rejection of claims 9-11, 13 and 15-18 incorporates the above discussed flawed combination of Reichman and Auclair, and therefore inherits all the deficiencies of the Examiner's rejection of independent claim 1 and claims 2-4 and 6-8 as discussed above.

Claim 9 employs language very similar to that of claim 1. In particular, claim 9 recites, in pertinent part:

a one piece movable member comprising a movable jaw, a second guide portion, and a receiving cavity, said receiving cavity at least partially defines the second guide portion, and receives the first guide portion, wherein said first guide portion and said second guide portion are configured for sliding engagement to guide longitudinal movement of said movable member with respect to said base to form a clamp, said first guide portion and said second guide portion having a pair of opposing ribs and a pair of opposing channels which cooperate with said ribs.

Applicant directs the Examiner's attention to the enclosed authoritative definitions of the claim term "cavity". As previously discussed, no cavity is present in the Reichman reference. Reichman discloses a clamp typical of the prior art. A similar clamp is disclosed in U.S. Patent No. 4,159,859 to Shemtov. These clamps are inexpensively produced from three simple parts. The parts simple shapes allow them to be formed by extrusion. A first c-shaped extruded member forms the body of the clamp and a second rectangular slab of extruded material forms the movable jaw member. The movable jaw is compressed against the lower part of the c-shaped clamp member by a fastener threadably engaged with the upper part of the c-shaped clamp member. A rear surface of the movable jaw slides along the planar inside surface of the c-shaped member to guide movement of the movable jaw. There is no disclosure, teaching or suggestion in Reichman of the need for a receiving cavity and inter-engagement between the clamp member and the movable jaw including cooperating ribs and channels as recited in claim 9. The Examiner attempts to address the deficiencies of Reichman by a combination with the teachings of Auclair. Applicant has addressed the legal and technical deficiencies of this proposed combination above in the context of


claim 1. Independent claim 9 is patentable for all the foregoing reasons over the Examiner's proposed combination of Reichman and Auclair. Claim 9 is patentable over the art cited by the Examiner.

Claims 10-18 are patentable for at least the reasons stated in support of claim 9.

Claim 17 recites in pertinent part "wherein said securement means comprises a first bolt engageable with said movable member and threadably engaged to said base. Claim 9 further recites "securement means that extends through the movable member for securing said base and movable member." The recitations of claim 17 modify those of claim 9 to require that the recited bolt pass through the movable member to threadably engage the base. As previously discussed in the context of claim 5, such a configuration is not disclosed, taught or suggested by Reichman. There is no teaching in Reichman or Auclair that the respective disclosure should be combined to arrive at Applicant's invention. Further, to incorporate the structures and relationships recited in claim 17 into the clamp of Reichman would require a wholesale redesign of that clamp. The Examiner has asserted no credible motivation for one of skill in the art to attempt such a massive modification of the respective references. Claim 17 is patentable for at least this additional reason.

For all the foregoing reasons, applicant respectfully requests allowance of claims 1-18.

Respectfully submitted,
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